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Application No. 09/706,101

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REMARKS

In the most recent Office Action, claims 1-3, 5-8, 10 and 12-35 were pending. Claims 29-32 are withdrawn from consideration. Claims 1-3, 5-8, 10, 12-28 and 33-35 stand rejected.

In response, claims 12-14 are canceled. Claims 1-3, 5-8, 10, 15-16, 19-25, 27-28 and 34-35 are amended. New claims 36-38 are added. Accordingly, claims 1-3, 5-8, 10 and 15-38 are pending in the application. No new matter is added.

Applicant responds to the comments in the Office Action as follows.

Claim Rejections - 35 U.S.C. § 112

The Office Action states that claims 1-3, 5, 12-14 19-28 and 33-34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. In particular, the Office Action states that the use of the term "optionally" produces a lack of clarity in the recitation of the claims. Claims 12-14 are canceled from the application without prejudice, thereby rendering the rejection of those claims under 35 U.S.C. § 112, second paragraph, moot. The rejection with respect to the remaining claims is respectfully traversed.

Claim 1 is amended to remove the term "optionally." Applicant submits that claim 1, and the claims dependent upon claim 1, are now definite. Accordingly, Applicant respectfully submits that the rejection of claims 1-3, 5, 19-28 and 33-34 under 35 U.S.C. § 112, second paragraph, is overcome, and respectfully requests that it be reconsidered and withdrawn.

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Claim Rejections - 35 U.S.C. § 103

The Office Action states that claims 1, 2, 6-7, 19, 21-23 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheinuk et al. (U.S. Patent Application Publication No. 2002/0198745), <http://www.acords.com> (hereinafter Choices), Leming (Chubb Lets Shippers Review Download Certificates Online, August 1999, Journal of Commerce, p. 8, hereinafter Leming), and further in view of Grow (U.S. Patent No. 6,694,315). In addition, the Office Action appears to reject claims 12-18, 27-28 and 35 on the same basis. In particular, the Office Action states that while Scheinuk et al. fail to explicitly disclose the functions (d-f), the same is taught by Choices, Leming and Grow in an obvious combination. Claims 12-14 are canceled from the application without prejudice, thereby rendering the rejection of those claims under 35 U.S.C. § 103(a) moot. Applicant respectfully traverses the rejection with respect to the remaining claims.

A review of the importance of the advantages provided by the present invention may be helpful in putting the prior art in proper perspective. The procedures for issuing a certificate of insurance are very specific, as they create legal obligations on the part of the issuer and the certificate holder. It is for these reasons that the present invention provides novel and unique features that are not available or contemplated in any other prior art systems. In prior art systems for producing a certificate of insurance, the content of the insurance coverage is strictly under control of the insurance agent who is responsible for the insured's insurance policy and coverage. Such a configuration makes intuitive sense, as the insurance agent, or producer, would

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not wish to permit a certificate holder to specify the obligations of the insured or an insurer. Accordingly, prior art certificate of insurance systems do not permit a certificate holder to specify insurance coverage, even when such would be conducive to enhancing the procedures for issuing a certificate of insurance. It is for these reasons that the present invention provides an advancement over the prior art, in that a certificate holder is permitted to select provisions of insurance coverage to be included in a certificate of insurance within the restrictions provided by the disclosed system and method. By permitting the certificate holder to specify insurance coverage content, based on selections limited by the insurance agent or insured, the present invention permits the issuing of certificates of insurance to be streamlined and improved.

The disclosures by Scheinuk et al. and Choices appear to discuss providing a certificate of insurance to a certificate holder. Importantly, the disclosures of Scheinuk et al. and Choices do not permit a third party to make changes related to the insurance coverage provided by the certificate of insurance. At most, Choices appears to indicate that a certificate holder can enter their name and address into the certificate of insurance and receive a resulting certificate through printing or viewing. In particular, neither Scheinuk et al. nor Choices disclose or suggest restriction criteria that restricts insurance coverage information specified in a certificate of insurance by a third-party requester, such as a certificate holder, as is recited in claim 1, for example.

The disclosure by Leming similarly fails to disclose or suggest restrictions on wording allowed and disallowed to prevent

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unauthorized insurance coverage information from being included in the certificate of insurance, as is recited in claim 1 of the present application. In addition, Leming appears to discuss insureds that can create certificate of insurance with free-form wording as required by a certificate holder. The disclosure of Leming does not appear to indicate that a certificate holder can create a certificate of insurance, as is possible with the invention recited in claim 1, for example.

Similarly, the disclosure by Grow fails to teach or suggest a third-party requester being enabled to input information as limited by restriction criteria to indicate insurance coverage to be provided under the certificate of insurance. At most, Grow appears to show the creation of documents containing text entered into a box. The disclosure by Grow does not disclose or suggest any of the key features recited in the claims of the present application, or the importance of permitting a third-party requester to input information, under certain restrictions, that contributes to defining the insurance coverage provided in a certificate of insurance.

Claim 1 of the present application recites computer program instructions to:

provide a second user interface for the third-party requester to select a specific insured by the access identification and specify insurance coverage information relative to the specific insured to be provided in the certificate of insurance, as restricted in accordance with the restriction criteria entered in the database by the first user to prevent inclusion of unauthorized insurance coverage information.

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Accordingly, a third-party requester can access the second user interface to create a certificate of insurance and input information as limited by restriction criteria through the second user interface to specify the insurance coverage or insurance coverage information provided by the certificate of insurance. The invention recited in claim 1 is unique in that the third-party requester, which can be the certificate holder or the insured, can formulate and create a custom certificate of insurance based on available selections or inputs through the second user interface that specify the insurance coverage to be provided in the certificate of insurance. In the cited prior art references of Scheinuk et al., Choices, Leming and Grow, there is no flexibility for a third party to request a certificate of insurance while specifying restricted insurance coverage provided in the certificate of insurance through a second user interface. The cited prior art reference of Choices appears to permit a third-party requester to enter a name and address into the certificate of insurance, which does not influence or change the insurance coverage provided under the certificate of insurance. The cited prior art reference of Leming appears to permit entry of free-form text by an insured, without limitation on the wording, and no facility for a certificate holder to create a certificate of insurance. Accordingly, the cited prior art references do not disclose or suggest all of the limitations that are recited in the rejected claims.

Moreover, there is no teaching or suggestion to combine the references of Scheinuk et al., Choices or Leming with that of Grow, or modify their teachings, to arrive at the invention recited in any of the rejected claims. Scheinuk et al.

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specifically avoids alteration of a certificate of insurance by a third-party requester, and Grow appears to be directed to permitting an internal user to enter text into a form document. That is, Grow does not teach or suggest permitting an external user, as might be equivalent to a third-party requester, to provide input into a form document. Accordingly, there is no teaching, suggestion or motivation to combine the references by Scheinuk et al., Choices, Leming and Grow.

Applicant therefore submits that claim 1 recites a number of limitations that are not found in the cited prior art references of Scheinuk et al., Choices, Leming or Grow, taken either alone or in combination with each other. Because the cited prior art references do not disclose all the claim limitations recited in claim 1, Applicant respectfully submits that the rejection of claim 1 under 35 U.S.C. § 103(a) over Scheinuk et al., Choices, Leming and Grow is overcome, and respectfully requests that it be reconsidered and withdrawn.

Claims 2, 19, 21-23, 27-28 and 33 ultimately depend upon and further limit claim 1, and should be allowable for all the same reasons as claim 1, and also because of the further limitations recited in each of those dependent claims. Applicant therefore respectfully submits that the rejection of claims 2, 19, 21-23, 27-28 and 33 under 35 U.S.C. § 103(a) over Scheinuk et al., Choices, Leming and Grow is overcome, and respectfully requests that it be reconsidered and withdrawn.

Claim 6 of the present application also recites elements related to permitting a third-party requester to specify insurance coverage information as limited by restriction criteria to be provided in the certificate of insurance that is to be created.

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As discussed above with respect to claim 1, the cited prior art references of Scheinuk et al., Choices, Leming and Grow fail to disclose or suggest these elements, either alone or in combination. Accordingly, Applicant respectfully submits that the rejection of claim 6 under 35 U.S.C. § 103(a) is overcome, and respectfully requests that it be reconsidered and withdrawn.

Claims 7 and 15-18 depend upon and further limit claim 6, and should be allowable for all the same reasons as claim 6, as discussed above, and also because of the further limitations recited in each of claims 7 and 15-18. Accordingly, Applicant respectfully submits that the rejection of claims 7 and 15-18 under 35 U.S.C. § 103(a) is overcome, and respectfully requests that it be reconsidered and withdrawn.

Claim 35 similarly recites permitting a third-party requester to define information related to insurance coverage as restricted by a restriction criteria to be provided in the certificate of insurance in the process of creating a certificate of insurance. As discussed above, none of the cited prior art references of Scheinuk et al., Choices, Leming or Grow disclose or suggest these elements, either alone or in combination with each other. Accordingly, Applicant respectfully submits that the rejection of claim 35 under 35 U.S.C. § 103(a) over the disclosures by Scheinuk et al., Choices, Leming and Grow is overcome, and respectfully requests that it be reconsidered and withdrawn.

The Office Action states that claims 3, 5, 8, 10, 24-26 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheinuk et al., Choices, Leming and Grow, and further in view of Luchs et al. (U.S. Patent No. 4,831,526). In particular, the Office Action states that Scheinuk et al. in view of Choices,

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Leming and Grow teach all the elements of the rejected claims with the exception of an approval response from an approving party, which is taught in the disclosure by Luchs et al. in an obvious combination. Applicant respectfully traverses the rejection.

The Office Action states that Scheinuk et al. teach a database operable to store information about an approving party, and operative to send an electronic message that includes at least a portion of a proposed certificate of insurance prior to generating the certificate of insurance. However, a review of the disclosure by Scheinuk et al., including paragraphs 0049 and 0089 cited in the Office Action, reveal that Scheinuk et al. is completely silent with respect to an approving party. Furthermore, Scheinuk et al. is completely silent with respect to storing information in a database about an approving party. In addition, Scheinuk et al. is completely silent regarding a computer system operative to send an electronic message to the approving party, as is recited in claim 3, for example. What is more, Scheinuk et al. is completely silent regarding an electronic message sent to an approving party that includes at least a portion of a proposed certificate of insurance. Accordingly, it appears that the Office Action reads into the cited prior art reference of Scheinuk et al. disclosure that the reference does not, in fact, contain.

The Office Action also states that Luchs et al. teach generating an insurance document if an approval response is received from an approving party. Yet, the disclosure by Luchs et al. is apparently concerned only with automated issuance of insurance policies and premium quotes for insurance policies. Accordingly, any approval mentioned in the disclosure by Luchs et



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al. is related only to issuing an underlying insurance policy, not a certificate of insurance. Claims 3, 5, 8, 10, 24-26 and 34 are directed to issuance of a certificate of insurance and indicating the need for or obtaining approval prior to issuance of the certificate. Because the cited prior art references of Scheinuk et al., Choices, Leming, Grow and Luchs et al. are silent with respect to these elements, Applicant submits that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established regarding claims 3, 5, 8, 10, 24-26 and 34, when the references are taken alone or in combination with each other. Moreover, claims 3, 5, 8, 10, 24-26 and 34 ultimately depend upon and further limit claims 1 and 6, and should be allowable for the same reasons as claims 1 and 6, as discussed above, and also because of the further limitations recited in each of the dependent claims. Accordingly, Applicant respectfully submits that the rejection of claims 3, 5, 8, 10, 24-26 and 34 under 35 U.S.C. § 103(a) is overcome, and respectfully requests that it be reconsidered and withdrawn.

Claims 27-28 also call for a selection through the second user interface to modify insurance characteristics provided by the requested certificate of insurance. As discussed above, with respect to claims 15-18, the disclosures by Scheinuk et al., Choices and Grow do not disclose or suggest these limitations, either alone or in combination with each other. In addition, claims 27-28 ultimately depend upon and further limit claim 1, and should be allowable for all the same reasons as claim 1, and also because of the further limitations recited in claims 27-28. Accordingly, Applicant respectfully submits that the rejection of claims 27-28 under 35 U.S.C. § 103(a) over the disclosure of

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Scheinuk et al. in view of Choices and further in view of Grow, is overcome, and respectfully requests that it be reconsidered and withdrawn.

The Office Action states that claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheinuk et al. in view of Choices and further in view of McKee et al. (U.S. Patent No. 6,272,482). In particular, the Office Action states that while Scheinuk et al. does not explicitly teach inputting a maximum and minimum number of cancellation days for comparison to a requested number of cancellation days to produce an error message, the same is taught by McKee et al. in an obvious combination. Applicant respectfully traverses the rejection.

The Office Action states that Scheinuk et al. in view of Choices teaches the system of claim 19 upon which claim 20 depends. Applicant respectfully submits that Scheinuk et al. fail to disclose or suggest any type of interface that permits a third-party requester for a certificate of insurance to input a selection, as restricted by a restriction criteria, for a type of insurance to be provided under the certificate of insurance, as discussed more fully above. In addition, the Office Action states that Scheinuk et al. further teach the second user interface is operable to input a requested number of cancellation days, referring to paragraph 0067 of the disclosure by Scheinuk et al. A review of the disclosure by Scheinuk et al., including paragraph 0067, reveals that any cancellation day input shown by Scheinuk et al. is internal to the system, in that such information originates with an agent or user from an insurance agency. Accordingly, Scheinuk et al. fail to disclose or suggest a second user

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interface that permits a third-party requester to input a requested number of cancellation days.

The Office Action further states that McKee et al. teach the use of business rules to establish a maximum and minimum number of cancellation days, citing column 4, lines 38-51 of the disclosure by McKee et al. A review of the disclosure by McKee et al., including column 4, lines 38-51, reveals that the disclosure is directed to a business rule that simply adds 15 days to whatever would be a minimum time for notification of auto policy cancellation. That is, McKee et al. appears to discuss adjustment of a notification period, not an auto policy cancellation period. Therefore, the disclosures by Scheinuk et al. in view of Choices, and further in view of McKee et al. fail to disclose or suggest all of the claim limitations recited in claim 20. Because the cited prior art references do not teach or suggest all the claim limitations, Applicant respectfully submits that the rejection of claim 20 under 35 U.S.C. § 103(a) over Scheinuk et al. in view of Choices and further in view of McKee et al. is overcome, and respectfully requests that it be reconsidered and withdrawn.

#### Response to Arguments

The Office Action states that the Examiner has now relied upon new grounds of rejection based on the Choices reference to teach a system that enables a third party to request and receive a certificate of insurance. As discussed above, Applicant submits that Choices appears to show a third-party requester being permitted to enter a name and address, which are items that do not influence the insurance coverage provided under the certificate of insurance. Accordingly, Applicant respectfully submits that the

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rejection of claims 1-3, 5-8, 10, 15-28 and 33-34 is overcome, and respectfully requests notice to the effect of allowability for these claims.

#### Conclusion

New claims 36-38 are added in the application to recite subject matter that Applicant has a right to claim. Entry and consideration on the merits is respectfully requested.

In view of the above amendments and discussion, Applicant respectfully submits that the application is now in condition for allowance, and earnestly solicits notice to that effect. The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

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